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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,666	02/09/2004	Brett Curry	5001-0435-1	9432

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EXAMINER	
KLEIN, GABRIEL J	

ART UNIT	PAPER NUMBER
3641	

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/774,666	CURRY, BRETT	
	Examiner	Art Unit	
	Gabriel J. Klein	3641	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 March 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Drawings

[001] The drawings were received on March 24, 2006. These drawings are acceptable.

Claim Rejections - 35 USC § 112

[002] The amendment of claim 10 to correct for the lack of antecedent basis for the term "said concave inner surface" is acknowledged.

Claim Rejections - 35 USC § 102

[003] Claims 1, 2, 10, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Moss et al (116078).

[004] In reference to claims 1 and 10, Moss et al discloses an extractor comprising an extractor plate having a plurality of arms extending radially outward from an inner portion of the plate, said arms forming a concave inner surface between adjacent arms, said inner surface substantially conforming to the profile of a bore of the cylinder; said inner surface having an arc length that is greater than one-half the circumference of a cartridge disposed within the cylinder bores of the revolver, said inner surface contacts the rim of a cartridge (figure 4). Further, said inner surface facilitates the removal of the cartridge from the bore (page 1, column 2, paragraph 2, lines 13 and 14). Further, Moss et al discloses a tubular stem having an end that is mounted to said inner portion of the extractor plate (page 1, column 2, paragraph 1, line 4, and figure 2, element A).

[005] In reference to claims 2 and 11, Moss et al discloses that said inner surface between adjacent arms is a substantially continuous curved concave surface (figure 4).

Further, Moss et al discloses at least one of said arms having a convex end portion (figure 4).

Claim Rejections - 35 USC § 103

[006] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

[007] Claims 3 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss et al as applied to claims 1 and 10. Moss et al discloses the claimed invention except for a substantially non-continuous/discontinuous concave surface between adjacent arms of said extractor plate. It would have been an obvious matter of design choice to use such a surface, since Applicant has not disclosed that a substantially non-continuous/discontinuous concave surface between adjacent arms solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with substantially continuous curved concave surfaces between adjacent arms.

[008] Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss et al in view of Philips (4543741). Moss et al discloses the

claimed invention except for the beveled edge on the inner surface between adjacent arms. Philips teaches that it is known to use a beveled edge as the contact point between extractor and cartridge as set forth in column 2, line 22, and figures 2 and 3, to engage the cartridge at its peripheral groove or rim. In a manner similar to Applicants, the examiner is considering the bore as starting forward of the extractor. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the extractor as taught by Moss et al, with the beveled edge as taught by Philips, since such a modification would provide the extractor with said beveled edge on said inner surface between adjacent arms to engage the cartridge at its peripheral groove or rim.

[009] Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss et al in view of Philips and further in view of *In re Boesch*. Moss et al in view of Philips discloses the claimed invention except for the beveled edge angle of about 60 degrees relative to the central axis of the cylinder of the revolver. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an angle of about 60 degrees for that of the beveled edge to engage the rim of the cartridge (which inherently has a similar angle), since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch,* 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

[010] Claims 6,15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss et al in view of Mochak (5218148). Moss et al discloses the claimed invention except for the abutment of the end portion of the extractor arms with

the inner surface of the cylinder. Mochak teaches that it is known to use an abutment between the end portion of the extractor arms and the inner surface of the cylinder as set forth in column 2, last paragraph, to minimize rotational or angular movement of the extractor plate relative to the bores. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the extractor as taught by Moss et al, with the abutment of the end portion of the arms with the inner surface of the cylinder as taught by Mochak, since such a modification would provide the extractor with the abutment of the end portion of the extractor arms with the inner surface of the cylinder to minimize rotational or angular movement of the extractor plate relative to the bores.

[011] Claims 7 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss et al in view of Mochak as applied to claims 6, 15, and 20. Moss et al in view of Mochak discloses the claimed invention but does not disclose expressly the end portions of the extractor arms having a concave surface. It would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the extractor as taught by Moss et al in view of Mochak with said end portions of the extractor arms having a concave surface, because Applicant has not disclosed that said end portions of the extractor arms having a concave surface provide an advantage, are used for a particular purpose, or solve a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with end portions of the extractor arms having rectilinear surfaces as taught by Moss et al in view of Mochak, because they minimize rotational or angular movement of the extractor

plate relative to the bores, and since it appears to be an arbitrary design consideration which fails to patentably distinguish over Moss et al in view of Mochak.

Therefore, it would have been an obvious matter of design choice to modify Moss et al in view of Mochak to obtain the invention as specified in the claims.

[012] Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mochak in view of Philips. Mochak discloses the claimed invention except for the beveled edge on the inner surface between adjacent arms. Philips teaches that it is known to use a beveled edge as the contact point between extractor and cartridge as set forth in column 2, line 22, and figures 2 and 3, to engage the cartridge at its peripheral groove or rim. In a manner similar to Applicants, the examiner is considering the bore as starting forward of the extractor. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the extractor as taught by Mochak, with the beveled edge as taught by Philips, since such a modification would provide the extractor with said beveled edge on said inner surface between adjacent arms to engage the cartridge at its peripheral groove or rim.

[013] Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mochak in view of Philips and further in view of *In re Boesch*. Mochak in view of Philips discloses the claimed invention except for the beveled edge angle of about 60 degrees relative to the central axis of the cylinder of the revolver. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use an angle of about 60 degrees for that of the beveled edge, since it has been held that discovering

an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch,* 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

[014] Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moss et al in view of Philips in view of Mochak and further in view of *In re Boesch*.

Moss et al in view of Philips, as applied to claim 8, discloses the claimed invention except for the abutment of the end portion of the extractor arms with the inner surface of the cylinder and the beveled edge angle of about 60 degrees relative to the central axis of the cylinder of the revolver.

Mochak teaches that it is known to use an abutment between the end portion of the extractor arms and the inner surface of the cylinder as set forth in column 2, last paragraph, to minimize rotational or angular movement of the extractor plate relative to the bores. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the extractor as taught by Moss et al in view of Philips, with the abutment of the end portion of the arms with the inner surface of the cylinder as taught by Mochak, since such a modification would provide the extractor with the abutment of the end portion of the extractor arms with the inner surface of the cylinder to minimize rotational or angular movement of the extractor plate relative to the bores.

Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use an angle of about 60 degrees for that of the beveled edge, since it has been held that discovering an optimum value of a result effective

variable involves only routine skill in the art. *In re Boesch,* 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

[015] Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Moss et al in view of Philips in view of Mochak in view of *In re Boesch* as applied to claims 17 and 18. Moss et al in view of Philips in view of Mochak in view of *In re Boesch* discloses the claimed invention except for a substantially non-continuous/discontinuous concave surface between adjacent arms of said extractor plate. It would have been an obvious matter of design choice to use such a surface, since Applicant has not disclosed that a substantially non-continuous/discontinuous concave surface between adjacent arms solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with substantially continuous curved concave surfaces between adjacent arms.

Response to Arguments

[016] Applicant's arguments filed March 24, 2006 have been fully considered but they are not persuasive.

[017] In regards to Applicant's arguments concerning the rejection of claims 1-2 and 10-11 under 35 U.S.C. §102(b) based on Moss et al, it should be appreciated that the issue is not if the drawings are to scale or not. The issue is whether the relative proportions within the confines of the reference provide a teaching. Since about 2/3 of the cartridge shell appears to be encompassed by the walls of the extractor as illustrated or taught in figure 4, regardless of whether the drawings as a whole are or are not to scale, this claim limitation is clearly met by Moss et al.

Further, Moss et al clearly states in column 2, second paragraph: "The arm is loaded when the cylinder is drawn forward, as in Fig. 2, when the cartridges can be successively attached to the plate D by being fitted into the grooved recesses of the same. The cylinder is then pushed back and locked by the ordinary lower catch *l*." Therefore, in order for the cartridges, particularly those that are on the bottom portion of plate D (the extractor), to remain in a position such that the cylinder may be pushed back to finish loading the firearm, it is inherent that the inner surface has an arc length greater than one-half the circumference of a cartridge disposed within the cylinder bores of the revolver. If this was not the case, then the cartridges attached to the bottom half of the plate D would fall down before the cylinder could be pushed back.

[018] In regards to Applicant's arguments concerning the rejection of:

- claims 3 and 12 under 35 U.S.C. §103(a) over Moss et al;
- claims 4 and 13 under 35 U.S.C. §103(a) over Moss et al in view of Philips;
- claims 5 and 14 under 35 U.S.C. §103(a) over Moss et al in view of Philips and further in view of *In re Boesch*;
- claims 6, 15, and 20 under 35 U.S.C. §103(a) over Moss et al in view of Mochak; and
- claims 7 and 16 under 35 U.S.C. §103(a) over Moss et al in view of Mochak;

It should be appreciated that in light of the response (from above) to the arguments made by Applicant concerning the rejection of claims 1-2 and 10-11 under 35 U.S.C. §102(b) based on Moss et al, a *prima facie* case of obviousness has been established since Moss et al clearly teaches an inner surface having an arc length that is greater

than one-half the circumference of a cartridge disposed within the cylinder bores of the revolver.

[019] In response to Applicant's argument that the holding of *In re Boesch* has been misstated, it should be appreciated that beveling the edge of an extractor is a *known process* as disclosed by Philips. Therefore, finding the optimum value of such a bevel is in agreement with the Courts holding "that discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art."

[020] In response to Applicant's argument concerning the rejection of claim 8 under 35 U.S.C. §103(a) over Mochak in view of Philips, it should be appreciated that the motivation to combine these references is not impermissible hindsight. The motivation to combine these references is clearly disclosed in column 2, paragraph 3, and figures 2 and 3 of Philips. Philips discloses that a tapered edge (beveled edge) is used to engage the rim of the casing, thereby holding the casing in position for firing. Therefore, the motivation to combine is as stated originally: "to engage the cartridge at its peripheral groove or rim". The Mochak reference is clearly analogous art and therefore it would be obvious to modify Mochak in view of Philips.

[021] In response to the arguments made by Applicant concerning the rejection of claim 9 over Mochak in view of Philips and futher in view of *In re Boesch*, it should be appreciated that beveling the edge of an extractor is a *known process* as disclosed by Philips. Therefore, finding the optimum value of such a bevel is in agreement with the Courts holding "that discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art." Further, the argument of

impermissible hindsight addressed to the combination of Mochak in view of Philips has been addressed in the above paragraph.

[022]] In response to the arguments made by Applicant in regard to the rejections of claims 17-19, it should be appreciated that the above responses regarding the disclosure of Moss et al, the Court holding of *In re Boesch*, and the argument of hindsight (in regards to Mochak in view of Philips) apply to these claims as well, and as such are not discussed in any further detail.

Conclusion

[023] THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriel J. Klein whose telephone number is 571-272-8229. The examiner can normally be reached on Monday through Friday 7:15 am to 3:45 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571-272-6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GJK

STEPHEN M. JOHNSON
PRIMARY EXAMINER